

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Hannebauer, Markus Oliver

Confirmation No. 9231

Application No.: 10/781,349

Attorney Docket No: 7390-X04-029

Filed: 02/17/2004

Group Art Unit: 2178

For: Method of Entering a Presentation into a  
Computer

Examiner: ABDUL-ALI, Omar R.

**RESPONSE TO OFFICE ACTION**

Mail Stop AF -- FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Examiner Abdul-Ali:

In reply to the Office Action mailed July 30, 2007, Applicants hereby submit the following declaration, remarks, and requests for reconsideration. A Request for Continued Examination accompanies this response. The request should remove the finality of the rejection and allow entry of the attached Declaration under Rule 1.131. Applicants submit this evidence and remarks serve to clarify the present invention and are independent of patentability.

In item 5 of the Office action, the Examiner rejected claims 1-40 as being unpatentable over Jaeger '290 in view of Farrah '997 and Balthaser '180 under 35 USC § 103(a).

Applicants attach a Declaration under Rule 1.131 to swear behind Jaeger '290. This rule states *inter alia* the following:

(a) When any claim of an application ... is rejected, the inventor of the subject matter of the rejected claim ..., may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date

of a ... U.S. patent application publication ... is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. ... Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

This rule is further interpreted in MPEP § 715.

Affidavits or declarations under 37 CFR 1.131 may be used, for example:

(B) To antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention.

Jaeger '290 is available as prior art under 35 USC § 102(e). The effective date of Jaeger '290 is its filing date, September 28, 2003.

The Declaration under Rule 1.131 shows that the invention as claimed in the instant application was conceived at least as early as February, 2003.

Conception is described in MPEP § 2138.04. Conception is defined therein as, "The complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930).

The attached Declaration under Rule 1.131 and supporting evidence shows that the inventors, Dr. Markus O. Hannebauer, Volker C. Schöch, and Arno Schödl, conceived of the invention as claimed at least as early as February, 2003. The Declaration references the Diploma Thesis of one of the inventors, Volker C. Schöch. The Declaration details where in the thesis the features of the claims are disclosed.

In addition, the attached Declaration under Rule 1.131 shows that the invention as claimed was reduced to practice at least as early as February, 2003. The standard for reduction to practice is detailed in MPEP § 2138.05.

The Declaration, which is collaborated by the Diploma Thesis, shows that the invention as claimed was actually reduced to practice at least as early as February, 2003. As shown in the Declaration under Rule 1.131, as part of the thesis, the inventor constructed a computer program that embodied a method of entering a presentation into a computer. As discussed previously, the features of the invention as claimed were embodied in this computer program. Furthermore, as shown in Chapters 5 and 6 of the thesis, the embodiment or process operated for its intended purpose: i.e. to speedup layout of presentations. The process was not only tested but it was practiced in the following way: by comparing layout times by applying the method and comparing them for layout times of unmodified PowerPoint presentations.

Because the invention was both conceived and reduced to practice before the effective date of Jaeger '290, due diligence is irrelevant.

In light of the Declaration under Rule 1.131, the attached evidence, and the remarks, Applicant has shown that the inventors conceived of the invention as claimed and reduced it to practice at least as early as February, 2003. Accordingly, the inventors have sworn behind Jaeger '290. Therefore, Jaeger '050 is no longer available as prior art.

The removal of Jaeger '050 by swearing back obviates all of the rejections in the Office action.

While the declaration is sufficient to remove the primary reference, Applicants have further comments explaining the invention and differentiating the prior-art references.

With regard to the rejection of Claims 5, 12 and 19, the invention does NOT "assign constraints to a subset of graphical objects by following the rules set by an automatic constraint solver". Actually, it is the other way round; the grid lines of containers and graphical objects impose a constraint system that is fed into a constraint solver. As its name implies, the constraint solver does not set rules for assigning constraints--it solves them. The result is a position assignment for the grid lines and therefore for the graphical elements. In this regard, the constraint system is different.

With regard to claims 24, 30, and 37, Balthaser '180 does not mention anything about sizing objects according to the guides.

With regard to claims 27 and 33, Balthaser '180 does not mention anything about maintaining the spacing of graphical elements to guides, setting an aspect ratio, maintaining a minimum size or text formatting.

#### Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No fee beyond that for the RCE is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 7390-X04-029).

Respectfully submitted,



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